

REMARKS

This Amendment is submitted in response to the Office Action dated June 13, 2003. In the Office Action, the Patent Office objected to the Claim 11 because of informalities. The Patent Office rejected Claim 9 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Moreover, the Patent Office rejected Claims 1, 4, 13, 14, 17 and 24 under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 4,063,520 to *Parsons*. Further, the Patent Office rejected Claims 2, 3, 15 and 16 under 35 U.S.C. §103(a) as being unpatentable over *Parsons* in view of *Gartner et al.* (U.S. Patent No. 6,298,699) Still further, The Patent Office rejected Claims 11 and 22 under 35 U.S.C. §103(a) as being unpatentable over *Parsons* in view of *Olson et al.* (U.S. Patent No. 6,561,339). The Patent Office indicate that Claims 5-8, 10, 12, 18-21 and 23 would be allowable if rewritten in independent form.

Applicant notes with appreciation that the Patent Office indicated that Claims 5-8, 10, 12, 18-21 and 23 would be allowable if re-written to include all of the limitations of the base claim and the intervening claims. To this end, Applicant added independent Claim 25-35 incorporating the dependent claims 5-8, 10, and 12 into Claim 1, and incorporating dependent claims 18-21 and 24 into Claim 14.

Moreover, by the present Amendment, Applicant amended Claims 1, 9, 11 and 14. Applicant submits that the amended claims overcome the rejections made by the Patent Office and place the application in condition for allowance. Notice to that effect is requested.

In the Office Action, the Patent Office rejected Claim 9 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particular point of and distinctly claim the subject matter which applicant regards as the invention. More specifically, the Patent Office alleges that the limitation "the combination" lacks antecedent basis. In response, Applicant has amended Claim 9 to read; "a combination." Applicant respectfully submits that the rejection under 35 U.S.C. §112, second paragraph, has been overcome. Notice to that effect is requested.

Further, in the Office Action, the Patent Office rejected Claims 1, 4, 13, 14, 17 and 24 under 35 U.S.C. §102 as being anticipated by U.S. Patent No. 4,063,520 to Parson. The Patent Office alleges that Parsons discloses a safe, an opening in said safe and cabinet in vertical communication with each other; deposit handling means including a deposit plate and a deposit actuator; means for preventing said cabinet door from being re-opened until another unlocking combination is inputted.

Amended Claim 1 requires a low profile depository cabinet-safe having a depository cabinet set atop and locked to said safe, forming an enclosed cabinet interior accessible through a

horizontally pivotally mounted lockable door by inputting an unlocking combination therein. Moreover, the safe has a deposit plate and a deposit actuator; a means for preventing the cabinet door from being re-opened until after unlocking combination is inputted to unlock the front door.

Amended Claim 14 requires a depository cabinet having a top cabinet wall, a plurality of downwardly descending cabinet side walls terminated by a bottom wall. The cabinet has an opening formed in the cabinet bottom wall, a deposit handling means in the cabinet having a horizontally positioned deposit plate moveable from inside the cabinet interior with said cabinet door, to outside said cabinet, when said cabinet door is fully opened, on which to place a deposit.

Parsons discloses a rockable customer operated door for a chute to a safe type receptacle as in a bank for receiving parcels and/or envelopes, which door may be unlocked by a key, and when opened exposes a pocket into which a parcel or letter may be dropped, and which during the manual closing of the door, a pivoted wall of the pocket ejects the contents thereof into the chute. Spring urged lever and ratchet means control the movement of the pocket wall to not only eject its contents but to scrape the walls thereof as well as to prevent reversing movement of the door intermediate the end of its travel. However, Parsons does not teach or suggest a low profile depository cabinet-safe having a

depository cabinet set atop and locked to said safe, forming an enclosed cabinet interior accessible through a horizontally pivotally mounted lockable door by inputting an unlocking combination therein as required by Claim 1. Moreover, Parsons does not teach or suggest a depository cabinet having a top cabinet wall, a plurality of downwardly descending cabinet side walls terminated by a bottom wall wherein the cabinet has an opening formed in the cabinet bottom wall, a deposit handling means in the cabinet having a horizontally positioned deposit plate moveable from inside the cabinet interior with said cabinet door to outside of the cabinet as required by Claim 14.

Anticipation requires that a single reference discloses each and every element of Applicant's claimed invention. *Akzo N.V. v. U.S. International Trade Commission*, 808 F.2d 1471, 1479, 1 USPQ 2d 1241, 1245 (Fed. Cir. 1986).

Moreover, anticipation is not shown even if the differences between the claims and the reference are "insubstantial" and one skilled in the art could supply the missing elements. *Structure Rubber Products Co. v. Park Rubber Co.*, 749 F.2d 707, 716 223 USPO 1264, 1270 (Fed. Cir. 1984).

In the Office Action, the Patent Office rejected Claims 2, 3, 15 and 16 under 35 U.S.C. §103(a) as being unpatentable over *Parsons* in view of *Gartner et al.* (U.S. Patent No. 6,298,699). The Patent Office

alleges that *Parsons* does not explicitly disclose an electric pushbutton lock that comprises a memory capable of recording date, time and access code. The Patent Office alleges that *Gartner et al.* teaches an electric pushbutton lock that comprises memory.

However, neither *Parsons* nor *Gartner et al.*, taken alone or in combination, teach a depository cabinet having a horizontally pivoting and/or positioned lockable depository cabinet door. Moreover, neither *Parsons* or *Gartner et al.*, teach or suggest a horizontally positioned deposit plate moveable from inside the cabinet interior.

Applicants respectfully submit that amended Claims 1 and 14 distinctly defines the present invention from *Parsons* and/or *Gartner et al.*, taken singly or in combination. Applicants submit the amendments to Claims 1 and 14 along with the above remarks overcome the rejection, and that Claims 1-24 are now in condition for allowance. Notice to that effect is requested.

It is submitted that the question under §103 is whether the totality of the art would collectively suggest the claimed invention to one of ordinary skill in this art. In re Simon, 461 F.2d 1387, 174 USPQ 114 (CCPA 1972).

That elements, even distinguishing elements, are disclosed in the art is alone insufficient. It is common to find elements somewhere in the art. Moreover, most if not all elements perform their ordained and expected functions. The test is whether the invention as a whole, in light of all of the teachings of the reference in its entirety,

would have been obvious to one of ordinary skill in the art at the time the invention was made. Connell v. Sears, Roebuck & Co., 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983).

It is insufficient that the art disclosed components of Applicants' invention, either separately or used in other combinations. A teaching, suggestion, or incentive must exist to make the combination made by Applicants. Interconnect Planning Corp. v. Feil, 774 F.2d 1132, 1143, 227 USPQ 543, 551 (Fed. Cir. 1988).

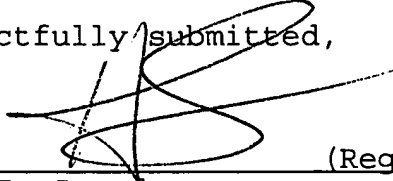
In view of the foregoing remarks and amendments, Applicants respectfully submit, the rejection under 35 U.S.C. §103(a) has been overcome and should be withdrawn. Notice to that effect is requested.

Moreover, Claims 2-13 depend from Claim 1; and Claims 15-24 depend from Claim 14. These claims are further believed allowable over the references of record for the same reasons set forth with respect to their parent claims since each sets forth additional novel elements of Applicant's depository cabinet. Thus, the amendments to Claims 1 and 14 render the rejection of Claims 2, 3, 15 and 16 under 35 U.S.C. 103(a) as being unpatentable over *Parsons* in view of *Gartner et al.*, moot.

In view of the foregoing remarks and amendments, Applicants respectfully submits that the drawings, and the Claim in the application are in allowable form and that the application is now in condition for allowance. If, however, any outstanding issues remain, Applicants urges the Patent Office to telephone Applicants's attorney

so that the same may be resolved and the application expedited to issue. Applicants requests the Patent Office to indicate all claims as allowable and to pass the application to issue.

Respectfully submitted,



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CERTIFICATE OF MAILING

I hereby certify that this **Amendment** is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to the Mail Stop Fee Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on October 13, 2003.



Valeina Jack